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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,274	11/25/2003	Peter J. Ford	884A.0025.U1(US)	2959
29683 7590 12/18/2009 HARRINGTON & SMITH, PC 4 RESEARCH DRIVE, Suite 202 SHELTON, CT 06484-6212			EXAMINER ELCENKO, ERIC J	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 12/18/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/725,274	<b>Applicant(s)</b> FORD ET AL.	
	<b>Examiner</b> ERIC ELCENKO	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 6,7,15 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,8-14,16-29 and 31-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 8-14 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Preston (U.S. Pat. No. 6,493,338) in view of Lielbriedis (U.S. Pub. No. 2001/0051528)

In regard to Claim 1, Preston teaches a terminal of a first party participating in a telephone call to a second party in the telephone call, (*cellular communication call, Col 3, Ln 24-30*) controlling a transmitter to send during the telephone call a data message; (*an In-Band signaling modem 28 enables cell phone 13 to transmit digital data 29 from a data source over the cellular network during the same wireless call. Col 3, Ln 64 – Col 4, Ln 2*)

Preston teaches the call being connected because of a destination number which is entered at the cell phone. (*Col 3, Ln 35-38*)

Preston does not directly disclose storing an identifier and using the stored identifier to automatically determine a destination address for a data message.

Lielbriedis teaches identifying information is transmitted to a mobile communication station in the originating address data space of a short message. At a later stage when the mobile responds to the message, the received originating address will constitute the destination address and the identifying information will be returned from the mobile station in the destination address data space of the response. Lin teaches the transfer of data between the two stations and it can obviously be seen that the address of the two mobiles is being used in the exchange as destination addresses for the communication. Lielbriedis is used to show specifically that information in data communication is sent automatically in a response to the originating terminal which sent the data.

It would have been obvious to one of ordinary skill in the art to modify Preston to include the teachings of Lielbriedis in order to directly respond to the communicating terminal using the original communication identification information as a destination address.

In regard to Claims 2-5, it is obvious to one of ordinary skill in the art that a identifier information that would be stored would be of the setup communication between the two terminals, including the telephone number, a CLI or equivalent.

In regard to Claim 8, Lielbriedis teaches storing the identifying information and being able to later retrieve the information for a response to the messages. (Para 9)

In regard to Claims 9 and 17, Lielbriedis discloses the destination address is any one of: an email address, a telephone number, a Bluetooth device address. (Para9, *it is also evident the connection is made in Lin by use of a telephone number between the devices*)

In regard to Claims 10-11, 18-19, Preston discloses providing, only during the telephone call a user selectable option to transfer data to the other party participating in the telephone call without user specification of a destination address. (*the In-Band signaling modem enables the phone to transmit digital data from the data source, Col 3, Ln 44-50*)

In regard to Claim 12, Preston et al. discloses a method of sending data from a first party participating in a telephone call to a second party in the telephone call (*an In-Band signaling modem 28 enables cell phone 13 to transmit digital data 29 from a data source over the cellular network during the same wireless call. Col 3, Ln 64 – Col 4, Ln 2*)

Preston teaches the call being connected because of a destination number which is entered at the cell phone. (*Col 3, Ln 35-38*)

Preston does not directly disclose storing an identifier and using the stored identifier to automatically determine a destination address for a data message.

Lielbriedis teaches identifying information is transmitted to a mobile communication station in the originating address data space of a short message. At a later stage when the mobile responds to the message, the received originating address will constitute the destination address and the identifying information will be returned

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from the mobile station in the destination address data space of the response. Preston teaches the transfer of data between the two stations and it can obviously be seen that the address of the two mobiles is being used in the exchange as destination addresses for the communication. Lielbriedis is used to show specifically that information in data communication is sent automatically in a response to the originating terminal which sent the data.

In regard to Claims 13 and 14, it is obvious to one of ordinary skill in the art that a identifier information that would be stored would be of the setup communication between the two terminals, including the telephone number received via the radio cellular transceiver, i.e., the call.

In regard to Claim 16, it would be obvious to one of ordinary skill in the art that each message stored from Lielbriedis and its associated identifying information would be connected to a different contact address as each is given a response to its respected received message.

In regard to Claims 33 and 34, Preston discloses a method of sending data from a first party participating in a telephone call to a second party in the telephone call (*an In-Band signaling modem 28 enables cell phone 13 to transmit digital data 29 from a data source over the cellular network during the same wireless call. Col 3, Ln 64 – Col 4, Ln 2*)

Preston teaches the call being connected because of a destination number which is entered at the cell phone. (*Col 3, Ln 35-38*)

Preston does not directly disclose storing an identifier and using the stored identifier to automatically determine a destination address for a data message.

Lielbriedis teaches identifying information is transmitted to a mobile communication station in the originating address data space of a short message. At a later stage when the mobile responds to the message, the received originating address will constitute the destination address and the identifying information will be returned from the mobile station in the destination address data space of the response. Lin teaches the transfer of data between the two stations and it can obviously be seen that the address of the two mobiles is being used in the exchange as destination addresses for the communication. Lielbriedis is used to show specifically that information in data communication is sent automatically in a response to the originating terminal which sent the data.

4. Claims 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Preston (U.S. Pat. No. 6,493,338) in view of Lielbriedis (U.S. Pub. No. 2001/0051528) in view of Paik et al. (U.S. Pub. No. 2008/0153471).

In regard to Claims 36-38, the combination does not directly disclose wherein using the stored identifier to determine automatically the destination address comprises interrogating a database using the stored identifier data to obtain the destination address.

Paik teaches a caller identifier detecting unit which detects an identifier of an originating mobile terminal, a control unit which controls storage of the caller identifier

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information, and a caller identification generating unit. The identifier managing unit 45 manages the identifier of the respective mobile terminal in the form of a database under the control of the control unit. (Para 45-47)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination to include the teaching of Paik. One of ordinary skill in the art could have combined the known prior art elements using known techniques to yield predictable results to one of ordinary skill in the art of a database logging the caller identifiers for a communication.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC ELCENKO whose telephone number is (571)272-8066. The examiner can normally be reached on M-F 7:30 AM through 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard can be reached on (571) 272-7603. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eric Elcenko/

/Patrick N. Edouard/

Supervisory Patent Examiner, Art Unit 2617